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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/826,190

04/15/2004

Thomas P. Vickery

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7590

02/14/2006

MERCK AND CO., INC

P O BOX 2000

RAHWAY, NJ 07065-0907

EXAMINER

GARBER, CHARLES D


ART UNIT

PAPER NUMBER

2856

DATE MAILED: 02/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/826,190	Applicant(s) VICKERY ET AL.	
	Examiner Charles D. Garber	Art Unit 2856	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 January 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 10-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Response to Arguments*

Applicant's arguments filed 01/20/2006 have been fully considered but they are not persuasive.

Applicant argues the Myers reference Examiner relied upon is directed to an apparatus to determine and measure the gas content of soils whereas the present invention is directed to an apparatus suitable for measuring the gas generation potential of various liquids capable of producing gases. Examiner considers the recitation that the apparatus is "for measuring the gas generation potential of various liquids capable of producing gases" not be given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951). Also, If a prior art structure is capable of performing the intended use as recited in the preamble, then it meets the claim. See, e.g., *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). Examiner considers the device of Myers is capable of performing the function of measuring the gas generation potential of various liquids capable of producing gases even though it is intended to be used with slightly different materials.

Applicant also argues Myers discloses inwardly extending baffles whereas the present invention does not. Examiner notes the claims at issue employ the transitional phrase "comprising". MPEP 2111.03 explains:

The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., > Mars Inc. v. H.J. Heinz Co., 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004) ("like the term comprising,' the terms containing' and mixture' are open-ended."); < Invitrogen Corp. v. Biocrest Mfg., L.P., 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003) ("The transition comprising' in a method claim indicates that the claim is open-ended and allows for additional steps."); Genentech, Inc. v. Chiron Corp., 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.); Moleculon Research Corp. v. CBS, Inc., 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); In re Baxter, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); Ex parte Davis, 80 USPQ 448, 450 (Bd. App. 1948) ("comprising" leaves "the claim open for the inclusion of unspecified ingredients even in major amounts"). >In Gillette Co. v. Energizer Holdings Inc., 405 F.3d 1367, 1371-73, 74 USPQ2d 1586, 1589-91 (Fed. Cir. 2005), the court held that a claim to "a safety razor blade unit comprising a guard, a cap, and a group of first, second, and third blades" encompasses razors with more than three blades because the transitional phrase "comprising" in the preamble and the phrase "group of" are presumptively open-ended. "The word comprising' transitioning from the preamble to the body signals that the entire claim is presumptively open-ended."

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Because the present invention employs an open ended transitional phrase it may not exclude the Myers reference invention with includes additional features such as the inwardly extending baffles.

The same reasoning applied to Applicant's arguments directed against the combination involving the Sullivan and Walles references.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

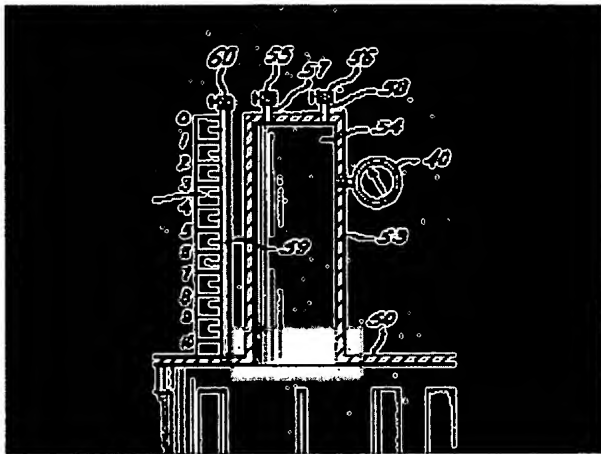
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Myers (US Patent 2,711,644).

Referring to Myers figure 3, container 10 is cylindrical vessel having openings at the top and bottom. It appears capable of holding a volume of a liquid capable of generating a gas.

The area highlighted below is a first port in cylinder 53. Gauge 40 is a pressure gauge which is a pressure reading means attached to a second port and valves 55 and 56 are valve means and pressure relief means respectively connected to third and forth ports in the cylinder 53. The cylinder may be considered to be a multi-port connector as in the instant invention.



Stuffing box 16, apparent in both of the Myers embodiments, may be considered a plugging means plugging the hole through which stirring shaft 15 passes in order to form a fluid tight seal.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2, 3, 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Myers (US Patent 2,711,644).

Regarding claim 2, Myers discloses the claimed invention except for the container volume between 50 and 150 ml. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a container volume between 50 and 150 ml, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

As for claim 3, Myers discloses the claimed invention except for the container fabricated from 316 stainless steel or C-22 alloy. It would have been obvious to one having ordinary skill in the art at the time the invention was made to fabricate the container from 316 stainless steel or C-22 alloy, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

As for claim 5, Myers discloses the claimed invention except for sensing pressure in the range from 0 to 60 psig. It would have been obvious to one having ordinary skill in the art at the time the invention was made to sense pressure in the range from 0 to 60 psig, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Myers (US Patent 2,711,644) in view of Sullivan et al. (US Patent 6598457)

Myers as applied above does not expressly teach the valve is a ball valve of stainless steel.

Sullivan, in a device measuring gas entrained in a liquid sample discloses a control valve 23 controls the amount of flow through an inlet 5. Sullivan teaches "Control valve 23 is preferably a ball valve, but may in the alternative include a diaphragm, butterfly, pinch, needle, gate, V-ball or iris control, or other suitable valve depending on application needs."

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a ball valve as this type of valve is preferred for control of fluid. Though the reference do not expressly teach the valve is of stainless steel it would have been obvious to one having ordinary skill in the art at the time the invention was made to make it from stainless steel, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Myers (US Patent 2,711,644) in view of Walles et al. (US Patent 3,578,404).

Myers as applied above does not teach pressure transducer or data logging software.

Walles teaches pressure sensing means 90 and intelligence processing means 140 which may be a computer "programmed to receive, store, and retrieve, such



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intelligence and deal with it in various ways" in the process of "ascertaining the rate of reaction that evolves...a gas". "By control under provided timing means, confined gas pressure is sensed in increments" towards determining "molar rate of reaction per mole of limiting reactant per unit time", "[o]ne of the more important characteristics of a chemical reaction...very difficult to determine".

It would have been obvious to one having ordinary skill in the art at the time the invention was made provide a pressure transducer and computer programmed so that pressure may be automatically monitored and recorded in order to measure pressure change as a function of time useful for determining chemical reaction rates in terms of moles.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles D. Garber whose telephone number is (571) 272-2194. The examiner can normally be reached on 8:00 a.m. to 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron Williams can be reached on (571) 272-2208. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Charles D. Garber  
Primary Examiner  
Art Unit 2856

cdg